

THE BODY SHOP INTERNATIONAL	}	IPC No. 14-2005-00020
PLC,	}	
Opposer	}	
	}	Opposition to:
	}	Appl. Ser. No. 4-1994-091394
-versus-	}	Date Filed: March 8, 1994
	}	
	}	
WILFREDO TUANQUI	}	TM: "BODYHOUSE"
Respondent-Applicant,	}	
x-----x	}	Decision No. 2006-22

DECISION

Before us is an Opposition filed by Body Shop International PLC, a company organized under the laws of the United Kingdom, having a principle place of business at Watersmead, Littlehampton, West Sussex BN 17 6LS, United Kingdom against the application filed on March 8, 1994 by Wilfredo Tuanqui with postal address at No. 7 Saturn Street, Pasig Greenland Village, Rosario, Pasig City bearing Serial No. 4-1994-091394 for the registration of the mark "BODYHOUSE" used for perfumes, cosmetics, hair preparation, soap and cologne under Class 3 of the international classification of goods, which application was published for opposition in Vol. VII, No. 7, page 31 of the Intellectual Property Office Official Gazette which was released on November 4, 2004.

Opposer filed its Verified Notice of Opposition on February 11, 2005. The grounds for Opposition are as follows:

"1. The registration of the mark subject of this opposition is contrary to the provisions of Sections 123.1 (d), (e) and (f) of Republic Act No. 8293, as amended;

"2. The Opposer is the owner of THE BODY SHOP mark which has been registered and applied for registration in the Opposer's name with the Intellectual Property Office in various classes;

"3. The Respondent-Applicant's mark nearly resembles the Opposer's THE BODY SHOP mark as to be likely to deceive or cause confusion. Hence, the registration of Respondent-Applicant's mark will be contrary to Sec. 123.1 (d) of the Republic Act No. 8293;

"4. Opposer is entitled to the benefits granted to foreign nationals under Section 3 of Republic Act No. 8293;

"5. The Opposer's THE BODY SHOP mark is well-known and world famous mark. Hence, the registration of the Respondent-Applicant's mark will constitute a violation of Article 6bis and 10bis of the Paris Convention in conjunction with Sections 3, 123.1 (e) and 123.1 (f) of Republic Act No. 8293;

"6. The use by Respondent-Applicant of the BODYHOUSE mark on the goods similar, identical or closely related to goods that are produced by, originate from, or are under the sponsorship of the Opposer will mislead the purchasing public into believing that Respondent-Applicant's goods are produced by, originate from, or are under the sponsorship of the Opposer.

"7. The denial of the application subject of this opposition is authorized under other provisions of Republic Act No. 8293."

In support of its opposition, Opposer stated and relied on the following facts:

“1. The Opposer is the owner of the THE BODY SHOP mark, which has been registered and applied for registration in the name of the Opposer in the Philippines and in other countries.

“2. The Opposer has been commercially using THE BODY SHOP mark in the Philippines and internationally prior to the filing date of the application subject of this opposition.

2.1 The well-known use of THE BODY SHOP mark in commerce by the Opposer and its predecessor-in-interest, in connection with cosmetics and cosmetic retail shops, began at least as early as 1976 in the United Kingdom and has been continuous, famous and uninterrupted ever since then.

2.2 In the Philippines, the goods bearing THE BODY SHOP mark have been sold as early as 1996. The first establishment using THE BODY SHOP mark opened in the Philippines in the same year.

“3. By reason of the appearance and significance, the Respondent-Applicant’s BODYHOUSE mark is confusingly similar to the Opposer’s THE BODY SHOP mark.

“4. The Opposer has not abandoned THE BODY SHOP mark and continues to use it in trade and commerce in the Philippines and in other countries.

“5. By virtue of the prior and continuous use by the Opposer of THE BODY SHOP mark in the Philippines and in other parts of the world, the mark has become popular and internationally well-known and has established for the Opposer valuable goodwill with the public which has identified the Opposer as the source of the goods and services bearing the said mark.

“6. The Opposer has extensively promoted THE BODY SHOP mark worldwide.

6.1 Over the years, the Opposer has obtained significant exposure for its goods upon which THE BODY SHOP mark is used, in various media including television commercials, outdoor advertisements, internationally well-known print publications, and other promotional events.

6.2 Currently, all of the Opposer’s products, labels, packaging, manuals, advertising, promotional materials, collateral material and its website ([the-body-shop.com](http://the-body-shop.com)), as well as related national and regional websites targeting specific local markets display THE BODY SHOP mark.

On March 4, 2005 a Notice to Answer was issued by this Office requiring the Respondent-Applicant to file his Answer within fifteen (15) days from receipt thereof. On June 9, 2005, this Office issued an Alias Notice to Answer. Thereafter, on August 16, 2005 Opposer filed a Motion to Declare Respondent in Default since Respondent-Applicant did not file an Answer. On August 24, 2005, Order No. 2005-635 was issued by this Office declaring Respondent-Applicant IN DEFAULT for failure to file the Answer within the reglementary period.

Subsequently, Opposer proceeded with the presentation of its evidence *ex-parte*. It initially submitted and marked exhibits but due to the implementation of Office Order No. 79 on September 1, 2005 prescribing therein the summary rules on Inter Partes cases, Opposer was directed to submit all his evidence in accordance with Section 7 and subsection 7.1 of Office Order No. 79 under Order No. 2005-883 dated October 11, 2005. On November 24, 2005 Opposer submitted its Compliance submitting as his Exhibits "A" to "B" the affidavits of Andre P.G. Betita and Susan N. Flook and Exhibit "C" the Verified Notice of Opposition. Additional evidence consisting of the certified copies of Opposer's various Philippine Trademark Registrations which were marked as Exhibits "D" to "S", were submitted on December 22, 2005. On January 5, 2006, this Office issued Order No. 2006-34 which noted and made of record the Compliance submitted by Opposer and directed Opposer to submit its Memorandum within fifteen (15) days from receipt of the Order. An additional period of ten (10) days was given to Opposer to file its Memorandum. On February 16, 2006, Opposer filed its Memorandum. Hence, this Decision.

The main issue to be resolved in this case is:

WHETHER OR NOT RESPONDENT-APPLICANT'S MARK "BODYHOUSE" IS CONFUSINGLY SIMILAR TO THE OPPOSER'S MARKS "THE BODY SHOP".

It is noteworthy to emphasize that the trademark subject of this opposition was filed on March 8, 1994, hence, the law that should be applied in this case is Republic Act No. 166, as Amended.

The pertinent provision of Republic Act No. 166, as Amended, that is applicable in this case is Section 4 (d) thereof, which provides:

*"Section 4. Registration of trademarks, trade names and service marks on the principal register. There is hereby established a register of trademarks, trade names and service marks which shall be known as the principal register. The owner of a trademark, trade name or service mark used to distinguish his goods, business or services from the goods, business or services of others shall have the right to register the same on the principal register unless it:*

xxx

xxx

xxx

*"(d) Consist of or comprises a mark or trade name which so resembles a mark or trade name registered in the Philippines or a mark or trade name previously used in the Philippines by another and not abandoned, as to be likely, when applied to or used in connection with the goods, business or service of the applicant, to cause confusion or mistake or to deceive purchasers.*

A cursory examination of Opposer's mark THE BODY SHOP and Respondent-Applicant's BODY HOUSE show that both marks contain the dominant word "BODY". Furthermore, both marks cover goods which fall under Class 3 of the International Classification of Goods.

What is more, evidence would show that the trademark THE BODY SHOP has been registered by Opposer in the Philippines since July 24, 1991 in various classes of goods including Class 3 which is the same as that of Respondent-Applicant's goods i.e., perfumes, cosmetics, hair preparation soap and cologne.

In trademark cases, jurisprudential precedents should be applied only to a case if they are specifically in point. The Supreme Court in a line of cases held "that in cases involving infringement of trademarks, it has been held that there is infringement when the use of the mark involved would be likely to cause confusion or mistake in the mind of the public or to deceive

purchasers as to the origin or source of the commodity; that whether or not a trademark causes and likely to deceive the public is a question of fact which is to be resolved by applying the "test of dominancy," meaning, if the competing trademark contains the main or essential or dominant features of another by reason of which confusion and deception are likely to result, then infringement takes place; and that duplication or imitation is not necessary, a similarity of the dominant features of the trademark would be sufficient.

In latest case of *MCDONALD'S CORPORATION, ET.AL. vs. L.C. BIG MAK BURGER, INC., ET.AL.*, the Supreme Court pronounced, to wit:

"In determining likelihood of confusion, jurisprudence has developed two tests, the dominancy test and the holistic test. The dominancy test focuses on the similarity of the prevalent features of the competing trademarks that might cause confusion. In contrast, the holistic test requires the court to consider the entirety of the marks as applied to the products, including the labels and packaging, in determining confusing similarity. xxx

This Court, however, has relied on the dominancy test rather than the holistic test. The dominancy test considers the dominant features in the competing marks in determining whether they are confusingly similar. Under the dominancy test, courts give greater weight to the similarity of the appearance of the product arising from the adoption of the dominant features of the registered mark, disregarding minor differences. Courts will consider more the aural and visual impressions created by the marks in the public mind, giving little weight to factors like prices, quality, sales outlets and market segments.

Thus, in the 1954 case of *Co Tiong Sa v. Director of Patents*, 60 the Court ruled:

. . . It has been consistently held that the question of infringement of trademarks is to be determined by the test of dominancy. Similarity in size, form and color, while relevant, is not conclusive. If the competing trademark contains the main or essential or dominant features of another, and confusion and deception is likely to result, infringement takes place. Duplication or imitation is not necessary; nor is it necessary that the infringing label should suggest an effort to imitate. (*G. Heliman Brewing Co. vs. Independent Brewing Co.*, 191 F., 489, 495, citing *Eagle White Lead Co. vs. Pflugh* (CC) 180 Fed. 579).

The test of dominancy is now explicitly incorporated into law in Section 155.1 of the Intellectual Property Code which defines infringement as the "colorable imitation of a registered mark . . . or a dominant feature thereof."

Opposer's mark "BODY" is being used and imitated in Respondent-Applicant's mark 'BODYHOUSE' which is the dominant feature of the mark with the addition only of the word HOUSE. Their difference pale into insignificance in view of the presence of the main or essential or dominant feature 'BODY' in Respondent's mark as to be likely, when applied to or used in connection with the goods perfumes, cosmetics, hair preparation, soap and cologne which are similar or closely related to Opposer's goods, to deceive and mislead the purchasing public into believing that Respondent-Applicant's goods are under the sponsorship of the Opposer. An unfair competitor need not copy the entire mark to accomplish its fraudulent purposes. It is enough if he takes the one feature which the average buyer is likely to remember. Indeed, measured against the dominant-feature standard, applicant's mark must be disallowed. For, undeniably, the dominant and essential feature of the article is the trademark itself.

Furthermore, a boundless choice of words, phrases and symbols is available to one who wishes a trademark sufficient unto itself to distinguish his product from those of others. When, however, there is no reasonable explanation for the defendant's choice of such a mark though

the field for his selection was so broad, the inference is inevitable that it was chosen deliberately to deceive.

In the case of American Wire & Cable Co. vs. Director of Patents, 31 SCRA 544, the Supreme Court held:

“As in all other cases of colorable imitations, the unanswered riddle is why, of the millions of terms and combinations of letters and designs available, the appellee had to choose a trademark so closely similar to another’s trademark if there was no intent to take advantage of the goodwill generated by the other mark.”

WHEREFORE, premises considered, the Notice of Verified Opposition filed by Opposer, THE BODY SHOP INTERNATIONAL PLC., against Respondent-Applicant WILFREDO TUANQUI is, as it is hereby SUSTAINED. Consequently, the trademark application for “BODYHOUSE” bearing Serial No. 4-1994-091394 filed on 08 March 1994 by Respondent-Applicant for perfumes, cosmetics, hair preparation, soap and cologne under Class 3 of the International Classification of goods is, as it is hereby, REJECTED.

Let the filewrapper of BODYHOUSE subject matter of the instant case be transmitted to the Administrative, Financial and Human Resource Development Services Bureau (AFHRDSB) for appropriate action in accordance with this DECISION with copy furnished to the Bureau of Trademarks for update and record purposes.

SO ORDERED.

Makati City, 31 March 2006.

ESTRELLITA BELTRAN-ABELARDO  
Director, Bureau of Legal Affairs  
Intellectual Property Office